

ESTTA Tracking number: **ESTTA440680**

Filing date: **11/11/2011**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91197754
Party	Defendant Laundry Acquisition Inc. (by change of name from Lavatec, Inc.)
Correspondence Address	JOHN C LINDERMAN MCCORMICK PAULDING HUBER LLP 185 ASYLUM STREET, CITY PLACE II HARTFORD, CT 06103 UNITED STATES lind@ip-lawyers.com
Submission	Motion to Compel Discovery
Filer's Name	John C. Linderman
Filer's e-mail	lind@ip-lawyers.com
Signature	/John C. Linderman/
Date	11/11/2011
Attachments	Motiontocompel.pdf (15 pages)(438885 bytes)

IN THE UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark Application No. 76701998
for the mark: LAVATEC
Published on November 2, 2010

_____)	
Wolf-Peter Graeser,)	
)	
Opposer)	
)	Opposition No. 91197754
v.)	
)	
Lavatec, Inc. (fka Laundry Acquisition Inc.)))	
)	
Applicant)	
_____)	

APPLICANT'S MOTION TO COMPEL DOCUMENT RELEASE FOR TRANSLATION

Applicant Lavatec, Inc. requests the Board to issue an Order compelling Opposer to release for translation into English by a consultant selected by Applicant a certain Asset Purchase Agreement by which Opposer bases its sole claim to the opposed mark LAVATEC. Opposer's counsel has refused Applicant's request, and insists that Applicant does not need a translation because a partial translation provided by Opposer is sufficient and independent. Opposer's translation is neither sufficient, independent, nor accurate.

BACKGROUND

Opposer's sole claim to the opposed mark LAVATEC is based upon the terms of a certain Asset Purchase Agreement by which the assets of a debtor company Lavatec GmbH (Lavatec Germany) were purchased in a bankruptcy proceeding in Germany. See Paragraph 20 of the Notice of Opposition. The conveying party/Seller in the Agreement is the receiver/conservator of debtor Lavatec Germany in the bankruptcy

proceeding. The Buyer is another German company in which Opposer is a major stockholder.

In view of the fact that the bankruptcy proceedings were conducted under the bankruptcy laws of Germany and the parties on all sides were German, the Asset Purchase Agreement is in German. Opposer has designated the Agreement “Trade Secret/ Commercially Sensitive” under the Board’s Standard Protective Order. In spite of repeated requests, Opposer’s attorneys have refused to release the Agreement for translation into English by a disinterested consultant selected by Applicant and subject to approval by Opposer pursuant to the terms of the Protective Order.

ARGUMENT

A. Procedure

Under the terms of the terms of the Standard Protective Order, disclosure of protected material is governed by Pars. 3 – 5. Disclosure to independent experts or consultants is governed by Par. 5. When parties are unable to resolve differences concerning disclosure to experts or consultants, and the matter is brought before the Board, the party (here, Applicant) seeking disclosure must present “an explanation of the need for disclosure” and the efforts made in seeking permission to disclose the Asset Purchase Agreement.

B. Applicant’s Need for the Translation and Efforts to Obtain the Translation

Since the Asset Purchase Agreement is Opposer’s sole basis for his claim to the mark LAVATEC, the need should be obvious. Applicant needs the translation to assess Opposer’s claim to the LAVATEC mark and to rebut the Opposer’s claim before the Board.

Applicant also needs a translation to point out the bias, deficiencies and errors in the partial translation provided by Opposer.

As indicated in the attached Exhibit 1, Applicant’s counsel requested consent to obtain a translation in August 22, 2011. After a reminder from Applicant’s consul and production of an incomplete translation, Opposer replied on October 14, 2011 that a translation was not necessary because Opposer’s translation had been certified (Exhibit

2, pertinent portions highlighted) Applicant's counsel pressed the matter (Exhibit 3), and in response, Opposer's counsel again asserted that Applicant does not need a translation of the Asset Purchase Agreement because the translation provided by Opposer is "an official translation" certified by a German Consul. The Consul is believed to be a licensed attorney in both Germany and the United States, and therefore, he "is perfectly qualified to translate the document in question." Opposer's consul then states "there can be no question as to the qualification and independence of the translator." (Exhibit 4).

However, the statements of Opposer's counsel were refuted and shown to be deceitful and deceptively misleading a week later when it was revealed in a response to Applicant's Interrogatory 9 (Exhibit 5) that the German Consul was not the translator of the Asset Purchase Agreement. Furthermore, the partial translation of the Agreement was prepared by Opposer's counsel, the name partner in the Stuttgart office of Reinhardt LLP. The deceitful statements warrant sanctioning of Opposer's counsel.

It should also be pointed out that the German Consul who allegedly certified the Opposer's translation has not responded to telephone and email inquiries from Applicant's counsel. See Exhibit 6.

Still further, the partial translation of the Agreement by Opposer's counsel omits a critical reservation clause stating that the Seller has put the Buyer (Opposer's company) on notice that Lavatec Germany does not have exclusive rights to the designation "LAVATEC" because Lavatec, Inc. USA (Applicant) and Lavatec France have the right to the designation to carry on the work of their respective companies.

When the omission of the critical reservation clause was pointed out by Applicant's counsel, Opposer's counsel explained the omission by stating, "...the translator was requested to translate all sections relevant to 'intellectual property rights'. The additional sentence, which we are having the Consul prepare a certified translation of, was not translated, as it does not relate to intellectual property rights, as we have been telling your client (Applicant) for over a year now." (Exhibit 4). Note the actual translator had not been revealed at the time of this statement.

While Opposer's counsel asserts that the translations are "independent" because they have been certified by a German Consul, it is clear that the portions translated or omitted have been selected by Opposer's counsel. Additionally, the German Consul was not selected by Applicant, has not responded to Applicant's inquiry, and has not been diligent in certifying the translations in view of numerous errors and omissions in Opposer's translation.

Conclusion

Opposer's counsel have been deceitful and deceptive in representing their translation prepared by co-counsel as independent and accurate when critical provisions have been deliberately omitted. Opposer's counsel have not been cooperative. Based on a claim of confidentiality, which itself is dubious since Opposer's purchase of assets of Lavatec Germany is known and admitted, Opposer's counsel are attempting to block Applicant from obtaining its own translation of a document on which Opposer's sole claim to the LAVATEC mark is based. Under the American system of jurisprudence, it is inconceivable that such obstruction can be used to prevent Applicant from challenging Opposer's claim.

Accordingly, it is requested that Opposer's counsel be sanctioned and ordered to release the Asset Purchase Agreement for translation into English by a consultant selected by Applicant pursuant to the provisions of Paragraphs 4 and 5 of the Board's Standard Protective Order.

Respectfully requested
LAVATEC, INC., Applicant

By s/ John C. Linderman
John C. Linderman
Richard J. Twilley
McCormick, Paulding & Huber LLP
185 Asylum Street, CityPlace II
Hartford, CT 06103-3410
Ph. 860 549-5290

lind@ip-lawyers.com
twilley@ip-lawyers.com
Attorneys for Applicant

CERTIFICATE SERVICE

The undersigned hereby certifies that a copy of the foregoing

APPLICANT'S MOTION TO COMPEL DOCUMENT RELEASE FOR TRANSLATION

was sent by email and served by First Class U.S. Mail, postage prepaid this 11th day of November 2011, to the following counsel of record:

Atty. Andrea Fiocchi
Atty. Sarah E. Tallent
44 Wall Street, 10th Fl
New York, NY 10005

By s/John C. Linderman
John C. Linderman

John C. Linderman

Monday, August 22, 2011 5:30 PM

Subject: Graeser Production Documents

Date: Monday, August 22, 2011 5:30 PM

From: John C. Linderman <lind@ip-lawyers.com>

To: Andrea Fiocchi afiocchi@reinhardt-law.com, Sarah Tallent stallent@reinhardt-law.com

Dear Mr. Fiocchi:

I have received your response to Applicant's first Document Request and have started to review documents produced. Exhibit 1 is ^{an} Asset Purchase Agreement in German and is labeled Trade Secret/Commercially Sensitive. You have included a partial translation with the Agreement.

We would like to have the Agreement reviewed and translated by a German attorney. Since the purchase price would seem to be the only sensitive information in the document, and the purchase price is already redacted, would you authorize us to transmit the document to a German attorney not otherwise involved in the trademark dispute for review and possible translation?

John C. Linderman

+=====+

Intellectual Property Law
Patents, Trademarks, Copyrights,
Computer Law, Trade Secrets,
Technology Transfer

+=====+

McCormick, Paulding & Huber
CityPlace II
185 Asylum Street
Hartford, Connecticut 06103
Phone: 860.549.5290 Ext. 1004
Fax: 860.527.0464

lind@ip-lawyers.com

Please visit our WEB SITE: <http://www.ip-Lawyers.com>

+=====+

The information contained in this e-mail communication may contain confidential and/or privileged information. The information is only for the use of the individual or entity named. If you are not the intended recipient of the information, or the employee or agent responsible to deliver it to the intended recipient, you are notified that your review, use, dissemination, disclosure, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by return e-mail, and destroy any physical and electronic copies of the communication.

+=====+

Exhibit 1

From: Sarah Tallent <stallent@reinhardt-law.com>
Date: Fri, 14 Oct 2011 18:09:02 -0400
To: "John C. Linderman" <lind@ip-lawyers.com>
Cc: Andrea Fiocchi <afiocchi@reinhardt-law.com>, "Kai N. Livramento" <klivramento@reinhardt-law.com>
Subject: RE: Graeser v. Lavatec, Inc.

Mr. Linderman:

Please find below in red, our answers to your questions.

. . .

-----Original Message-----

From: John Linderman [<mailto:lind@ip-lawyers.com>]
Sent: Friday, September 23, 2011 11:05 AM
To: Andrea Fiocchi; Sarah Tallent
Subject: Graeser v. Lavatec, Inc.

Mr. Fiocchi/ Ms. Tallent:

Your Motion to Compel filed on September 9, 2011 asserting that I did not follow the rules was apparently filed in haste without due regard to the Notice of Suspension on August 8, 2011 and the Order from the Board not to file any documents unless they were germane to the then-pending motions. The Notice directed your attention to Rule 2.120(e)(2) which you have also violated. Rule 2.120(h)(2) can be added to the list.

We do not intend to violate the Notice and order, and therefore will not be filing a Response to your Motion. Your Motion was improper and will have to be re-instituted at a later date when proceedings resume.

In the meantime I have been reminded of the duty to cooperate, TBMP \$408.01, and that the Board "looks with extreme disfavor on those who do not." With this foremost in mind I list below substantive issues I have with your responses to Applicant's discovery requests. If we can work through the issues, I will give consideration to withdrawing my motion to compel. To avoid any conclusions to the contrary I am not withdrawing my motion to compel.

In your discovery responses, you interject and subsequently

rely upon general Objection 2 in the responses to Document Requests and Admissions, and Objection 3 in the response to Interrogatories. The Objections comprise refusals to identify documents or information that is confidential. The Objections and withholding of confidential information are improper. The handling of confidential information is governed by the standard protective order of the Board. We therefore ask you to respond fully to the discovery requests without withholding confidential documents or information.

Leaving aside our objection, our responses do not change. We have nothing to add.

The instructions included with our Interrogatories and Document Requests requested translations of any documents in a language other than English. You have provided a partial translation of Exhibit 1. However, we know you have a translation of more of the document than you provided. Please provide all of the various translations you have of the requested documents.

I am not sure where exactly you are getting your information from. I have one hard copy of the translation already provided which was certified as an accurate translation by the German Consul in Denver, which I am attaching to this email. You will note that it is the same as the document already provided. We have not had any other "translations" prepared. I do recall that in one communication with your client's bankruptcy counsel, the meaning of a phrase from the agreement was discussed. This document is already in your client's possession, but in the spirit of cooperation I am re-attaching it for you.

In regard to translations, we have not received a reply to our email of August 22, 2011 (attached) seeking permission to obtain our own translation of Exhibit 1. Please respond.

We conferred with our client and we hereby reiterate that the information contained in the Asset Purchase Agreement constitutes a trade secret/commercially sensitive information. Therefore, you are not permitted to transmit the document to a third party for translation.

As noted above, the translation provided was certified as accurate by the German Consul in Denver, an independent public official, therefore, I do not believe that another translation is necessary. A translation of all relevant sections has been provided. We can have the language contained in the attached

letter dated September 30, 2010, certified as a translation and will organize this as soon as possible. With a translation of that language, you have all relevant parts of the document translated. Furthermore, from reading your subsequent discovery requests, I understand that your level of German is already sufficient for you to be able to understand the document in question.

Applicant's Interrogatory 8 requested an explanation for any denials of Applicant's Requests for Admission. Opposer's response to Interrogatory 8(14) simply refers to Document Response 6 which is an objection and list of documents. Please provide an explanation for the denial as requested.

The order for the first sale of equipment was solicited at a time when Applicant had not been incorporated and the only existing entity was Opposer's predecessor in interest.

We also need to reach an agreement about service by electronic means and production of discovery documents electronically.

I believe that the agreement is already clear. If you prefer to use traditional service as well as electronic service, we have no objections.

If we can work out the issues with your discovery responses and procedures, we may move the Opposition forward.

John C. Linderman

Atty Tallent:

October 17, 2011

I am responding to your refusal to allow us to obtain an independent translation of the Asset Purchase Agreement on which Mr. Graeser bases his claim.

Surely you are not asserting that we must accept your partial translation containing those sections that Mr. Graeser most likely hand-picked and omitting the section(s) in derogation of his claim. We will identify the translator in advance to permit you to be assured of no conflict.

Please reconsider your decision and let me hear from you by October 21, 2011 if not sooner.

Additionally, please let me know when Mr. Graeser will be available for deposition between November 1 and November 23, 2011.

John C. Linderman

Exhibit 3

----- Forwarded Message

From: Sarah Tallent <stallent@reinhardt-law.com>

Date: Sat, 22 Oct 2011 23:22:36 -0400

To: "John C. Linderman" <lind@ip-lawyers.com>

Cc: Andrea Fiocchi <afiocchi@reinhardt-law.com>, "Kai N. Livramento" <klivramento@reinhardt-law.com>

Subject: RE: Graeser v. Lavatec, Inc.

Dear Mr. Linderman:

We have conferred with our client regarding your communications below. Please note the following:

1. As previously explained to you, the translation provided was an official translation certified as to its content by the German Consul in Denver, who is clearly an independent party. We are informed that the Consul is a licensed attorney in both Germany and the United States, therefore, is perfectly qualified to translate the document in question. We believe that there can be no question as to the qualification and independence of the translator.
1. As regards your claim that our client "hand-picked [sections] and omitting the section(s) refuting his claim", we'd like to point out that your constant diatribes against our client are becoming rather tiresome and that seeking to paint him as "the big bad wolf" at every opportunity is not a compelling legal argument and serves no purpose.
- 2.
3. In any case, as regards the choice of sections translated, the translator was requested to translate all sections relevant to "intellectual property rights". The additional sentence, which we are having the Consul prepare a certified translation of, was not translated, as it does not relate to intellectual property rights, as we have been telling your client for over a year now. Apparently, the language is even stronger in German. To remove any doubt that our client has engaged in "cherry picking", we have requested the translator to provide a confirmation that all sections relevant to intellectual property rights have been translated. |
1. Based upon the foregoing, there are absolutely no reasonable grounds for you to challenge the translation, therefore, we can call conclude that you will be satisfied with the documents to be provided.
1. We discussed your request regarding Mr. Graeser's schedule and he informs us that he has no plans to be in the United States between November 1st and November 23rd.

Please find attached our second round of discovery requests.

Very truly yours,

Sarah E. Tallent

Attorney at Law

Reinhardt LLP

44 Wall Street - 10th Fl.

New York, NY 10005

Ph: (212) 710-0970

Fax: (212) 710-0971

Email: stallent@reinhardt-law.com

New York ♦ Denver ♦ Stuttgart

Exhibit 4

In the matter of Trademark Application No. 76701998
for the mark: LAVATEC
Published on November 2, 2010

Opposition No. 91197754

Exhibit 5

Subject to and without waiving these General Objections, or any other objection or claim of privilege, Opposer hereby answers and objects to Applicant's Third Set of Interrogatories as follows.

INTERROGATORIES

9. Identify the translators of each translation obtained by Opposer, or on behalf of Opposer, of any document relied upon or produced by Opposer in the present Opposition, including identification of the document translated by the translator and the relationship between the translator to Opposer and his attorneys.

Answer to Interrogatory No. 9: Opposer objects to this Request on the grounds set forth in General Objections No. 6, 7 and 8. Notwithstanding the objections, Opposer states that the translation contained in Opposer's Exhibit 1 was prepared by Mr. Dierk H. Reinhardt, J.D., LL.M., Rechtsanwalt, attorney for Opposer, and reviewed, edited and officially certified as to the accuracy of its contents by Mr. Bernhardt Jurgen Bleise, Honorary Consul of the Federal Republic of Germany, attorney at law admitted to practice in the Federal Republic of Germany and Colorado, in his official capacity as Honorary Consul.

10. If Opposer denied, in whole or in part, any of the Requests for Admission served by Applicant on September 28, 2011, please explain the denials.

Answer to Interrogatory No. 10

19. Prior to the formation of Lavatec, Inc. in February 1987, Lavatec GmbH had not manufactured any commercial laundry equipment for designated customers in the United States.

Answer to Interrogatory No. 10(19): Opposer is in the process of retrieving relevant information and will provide Applicant with an explanation shortly.

20. Prior to the formation of Lavatec, Inc. in February 1987, Lavatec GmbH had not delivered any commercial laundry equipment for designated customers in the United States.

Answer to Interrogatory No. 10 (20): Opposer is in the process of retrieving relevant information and will provide Applicant with an explanation shortly.

CERTIFICATION

I certify that the foregoing answers to interrogatories are true to the best of my knowledge and based on all of the information presently known to me. I make this certification based on my personal knowledge of the records available to me as they are kept in the ordinary course of business, information obtained from other employees upon whom I regularly rely in the ordinary course of business or my general knowledge of the business practices.

Dated: October 28, 2011

By: /s/ Wolf-Peter Graeser

John C. Linderman

Tuesday, October 25, 2011 12:11 PM

Subject: Translation

Date: Tuesday, October 25, 2011 12:11 PM

From: John C. Linderman <lind@ip-lawyers.com>

To: bleisejd@qwestoffice.net

Dear Dr. Bleise:

I am an attorney involved in a trademark opposition in which your attached certification of an English translation of an Asset Purchase Agreement has been presented.

I have a few questions that I would like to ask you about the translation and certification. However, to be certain that I am not violating any confidentiality or attorney/client relationship, I must first ask if the translation was provided as a service of the German Consulate or in what capacity you provided the translation?

John C. Linderman

+=====+

Intellectual Property Law
Patents, Trademarks, Copyrights,
Computer Law, Trade Secrets,
Technology Transfer

+=====+

McCormick, Paulding & Huber
CityPlace II
185 Asylum Street
Hartford, Connecticut 06103
Phone: 860.549.5290 Ext. 1004
Fax: 860.527.0464

lind@ip-lawyers.com

Please visit our WEB SITE: <http://www.ip-Lawyers.com>

+=====+

The information contained in this e-mail communication may contain confidential and/or privileged information. The information is only for the use of the individual or entity named. If you are not the intended recipient of the information, or the employee or agent responsible to deliver it to the intended recipient, you are notified that your review, use, dissemination, disclosure, distribution or copying of this communication is strictly prohibited. If you have received this communication in error, please immediately notify us by return e-mail, and destroy any physical and electronic copies of the communication.

+=====+

Exhibit 6